

REMARKS/ARGUMENTS

With this response claims 1-5, 16-20 and 23 are pending; claims 6-15 are withdrawn as drawn to a non-elected invention; and claim 24 is cancelled.

Applicant acknowledges that the Office Action of January 25, 2010 indicates claim 3 is allowed.

Applicants reserve the right to pursue, without prejudice, any subject matter including claim(s) as originally filed and/or otherwise set forth or described in this present application and/or in an earlier or other application(s) such as a priority application(s). No new matter is added.

CLAIM AMENDMENTS

Claim 1 is amended for clarity and precision by reordering various limitations and to provide better antecedent basis. This amendment does not constitute the addition of new matter.

Claim 4 is amended to clarify the polymer is polyethylene glycol, poly(t-butyl acrylate), poly(t-butyl methacrylate), polyacrylamide, poly(arginine), glycolipid, glycoprotein and polysaccharide. Support for this amendment is found, for example, at paragraphs [024]-[025].

Withdrawn claim 6 is amended to be made dependent from allowed claim 3 and to improve clarity. Support for this amendment is found in the original claim and at paragraphs [018] and [035].

Withdrawn claim 7 is amended to correct antecedent basis in view of the amendment to claim 6.

Withdrawn claim 8 is amended to be made dependent from allowed claim 3.
Support for this amendment is found, for example, at paragraph [036].

Claim 16 is amended similarly to the amendment of claim 4. Support for this amendment is found, for example, at paragraphs [024]-[025].

Claim 23 is amended by incorporating the limitations of dependent claim 24.
Claim 24 is accordingly cancelled.

CLAIM OBJECTIONS (ITEM 3)

The Office objects to claims 1-2 and 5, alleging the claims lack clarity and precision of claim language. The Office suggests claim language and Applicants have adopted the Office's suggestions. Applicants request the objection to the claims be reconsidered and withdrawn.

CLAIM REJECTIONS – 35 U.S.C. § 112 (Item 4)

The Office rejects claims 4 and 16 under 35 U.S.C. 112, first paragraph and alleges they contain "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Applicants respectfully traverse this rejection in view of the amendments and remarks presented herein.

In support of this rejection, the Office states, "The claim does not establish what is intended by 'polymer'". The Office notes that the term polymer is recognized in the art as being a "large variable genus" and alleges, "The specification fails to provide any additional representative species of the claimed genus to show that applicant was in possession of the claimed genus." Further, the Office appears to be under the impression that the "specification describes the polymer as branched or linear and mentions PEG."

Applicants disagree with this characterization and specifically direct the Office to paragraphs [024] – [027] where a various polymer species conjugated to the recited

truncated thrombomodulin are disclosed. Furthermore, exemplary methods of conjugating a polymer to the claimed truncated thrombomodulin are explicitly provided in the specification (see, e.g., Scheme A (paragraphs [0067]-[0069]) and FIG. 5 (paragraph [078])).

Solely in the interest of facilitating prosecution, however, Applicants amend claims 4 and 16 by reciting specific polymers. The focused nature of these polymers in concert with the teachings of the specification does, in fact, satisfy the written description requirement as set forth in the recent Federal Circuit en banc decision (Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., 598 F.3d 1336, 1352, 94 U.S.P.Q.2d 1161 (Fed. Cir. 2010) (holding “the written description requirement does not demand either examples or an actual reduction to practice; a constructive reduction to practice that in a definite way identifies the claimed invention can satisfy the written description requirement”). In this case, Applicants specification itself demonstrates possession of the invention as provided in amended claims 4 and 16.

Furthermore, in the interest of facilitating prosecution, claim 23 is similarly amended to recite specific polymers.

REQUEST FOR REJOINDER

Claim 3, directed to the amino acid of SEQ ID NO:3 is indicated by the Office as allowed. Applicants specifically request claims depending therefrom, including withdrawn claims 6-12 be rejoined. In particular, claims 6 and 7 relate to a nucleic acid and are amended to be dependent from claim 3. Claims 8-12 are method claims that have been amended to depend from claim 3, and relate to a method of expressing the protein of claim 3 and specifically SEQ ID NO:3. Applicants specifically request that method claim 8, which contain all the limitations of the allowable product claim 3, and claims depending therefrom (claims 9-12) be rejoined in accordance with Office practice of rejoining method claims that contain all the limitations of the allowed product claim (see MPEP 821.04(b)).

CONCLUSION

In view of the foregoing, Applicants believe the claims are in condition for allowance and respectfully requests the case be passed to allowance. It is believed that an extension of time of one month is required with this submission. The fee for the extension of time is being submitted via the EFS-web payment system. If there are any difficulty with the payment, the amount is not correct, or additional fees are required, please deduct any necessary fees or credit any overpayments to Deposit Account No. 071969. If any outstanding issues remain, the Office is encouraged to contact the undersigned by telephone.

Respectfully submitted,

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